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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
PATENT
Attorney Docket No. 07099.0010-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Arlene M. Vance et al.

Serial No.: 08/951,630

Filed: October 16, 1997

For: **SYSTEM FOR CORPORATE
TRAVELER PLANNING AND
MANAGEMENT**



22852
PATENT, TRADEMARK OFFICE

Group Art Unit: 2768

Examiner: Frantzy Poinv

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Final Office Action dated March 28, 2000, the non-fee period for response to which extends through June 28, 2000, Applicants respectfully request reconsideration of this application and the timely allowance of all pending claims 1-93.

Based on the rationales provided on pages 2-12 of the Final Office Action, the Examiner rejected claims 1-93 under 35 U.S.C. § 103 as being unpatentable over Shoolery et al. (U.S. Patent No. 5,570,283). However, because Shoolery et al. fails to disclose or suggest each and every element recited in the claims, Applicants respectfully traverse these grounds for rejection for the following reasons.

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As discussed in the Amendment dated January 4, 2000 and throughout the specification, the present invention provides a number of practical advantages that are neither present in nor apparent from the prior art. For example, the specification states that

[m]any of the limitations on the current corporate travel planning and management systems stem from the corporate traveler's dependence on travel management firms. Travel management firms currently function as the central hub for all travel services and information regarding travel for the corporate traveler. There is a total reliance on the travel management firm by the travelers for trip planning and management as well as by the Corporate Travel Managers for summary reporting,

(p. 5, ll. 4-12). In order overcome these exemplary limitations of the prior art, the present invention provides a corporate travel planning and management system that allows the traveler – rather than the traveler's agent – to perform, among other things, automated travel planning and management from the corporate traveler's own desktop and inform the corporation of "planned travel expenditures before corporate dollars are spent," (p. 5, ll.13-19), and without the travel agent's prior involvement. It should be understood, however, that the invention is not limited to these illustrative examples in the specification. Rather, the invention is intended to cover all modifications and variations that come within the scope of the claims.

Turning to the claimed invention, each of the independent claims (i.e., claims 1, 12, 18, 20, 36, 48, 57, 64-67, 70, 73, 75, and 92), are drawn to different combinations of elements or method steps that patentably distinguish the claimed invention from the teachings of Shoolery et al.. For example, independent apparatus claim 1 recites a

combination of elements including, *inter alia*, a "traveler planning, expense reporting and travel management system [that] is configured for selectively allowing the traveler to complete a travel reservation and communicate the completed travel reservation to the travel agency for post reservation processing," (independent claim 1, ll. 11-14; see *also* claims 19, 57, 66, and 70). Similarly, independent method claim 12 recites the steps of "receiving from the traveler a completed travel reservation based on the traveler's approved travel plan; and communicating the completed travel reservation to the travel agency for post reservation processing," (claim 12, ll. 16-17; see *also* claims 20, 36, 48, 49, 65, 67, 73, and 75). Moreover, independent claim 92 recites the step of "determining whether the travel plan complies with a set of travel policies according to a travel policy hierarchy that defines a relationship between each travel policy within the set of travel policies," (claim 92, ll. 4-6). At the very least, Shoolery et al. fails to disclose or suggest these exemplary features of the claimed invention.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate each of three requirements. First, the teachings of Shoolery et al. must disclose or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (7th ed. 1998) (citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)). Second, if the Examiner proposes to modify or supplement the teachings of Shoolery et al. itself, a reasonable probability of success in such a modification must exist. See *id.* Third, there must be some suggestion or motivation, either in the teachings of Shoolery et al. itself or in the knowledge generally available to one of ordinary skill in the art, to modify

or supplement Shoolery et al. in a manner resulting in the claimed invention. See *id.*.

Finally, each of these requirements must be found in the prior art – not based on Applicants' own disclosure. M.P.E.P. § 2143 (7th ed. 1998) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Shoolery et al. discloses a travel management system that performs two broad functions. First, Shoolery et al. provides a corporate travel controller system that allows travelers (i.e., not travel agents) to access a computerized reservation system (CRS) (e.g., via user friendly software) so as to (1) view travel information, such as flight schedules or availability, (2) request a travel itinerary, and (3) obtain authorization from the traveler's supervisor, (see, e.g., col. 5, ll. 45-47). Second, Shoolery et al. includes various communication devices that enable the travel agent to actually "make a reservation in accordance with the requested and agreed upon itinerary," (col. 7, ll. 41-43). In summary, Shoolery et al. simply provides

[a] system for controlling travel primarily in a corporate environment that interconnects travelers, travel agent and airline CRSs so that a traveler can communicate with the CRS with a user friendly GUI to obtain schedule information and transfer such to a travel agent, the travel agent can use the selected schedule information for ticketing and to assure the lowest cost while the entire trip information is stored locally for management control,

(abstract, ll. 1-8).

However, Shoolery et al. fails to provide any disclosure whatsoever of "allowing the traveler to complete a travel reservation and communicate the completed travel reservation to the travel agency for post reservation processing (see generally apparatus claims 1, 19, 57, 66, 70; method claims 12, 20, 36, 48, 49, 65, 67, 73, and

75). Indeed, Shoolery et al. teaches away from the claimed invention by merely enabling travel "agents to make bookings in an assisted, simplified, consistent manner," (col. 5, ll. 47-48). By contrast, the present invention involves no travel agent intervention with the traveler's process of completing a travel reservation. In addition, Shoolery et al. does not disclose or suggest the step of "determining whether the travel plan complies with a set of travel policies according to a travel policy hierarchy that defines a relationship between each travel policy within the set of travel policies," (claim 92, ll. 4-6). Rather, Shoolery et al. teaches away from the claimed invention by simply disclosing the step of sending the traveler's requested travel itinerary to a supervisor's workstation for evaluation, (see col. 7, ll. 36-58). As a result, one of ordinary skill in the art would not even consider modifying or supplementing the teachings of Shoolery et al. in the manner suggested by the Examiner. Consequently, Shoolery et al. not only fails to disclose each and every element or step recited in the claims, but also undeniably teaches away from the claimed invention.

With this in mind, the Examiner asserts that Shoolery et al. teaches that allowing a traveler to complete a reservation was known at the time of the invention, (see Office Action page 2 (citing Shoolery et al. col. 5, ll. 44-59)). However, Shoolery et al.'s "modular software, computer system" only allows "travelers to electronically access airline inventories to obtain flight schedules very quickly in an user friendly environment, (col. 5, ll. 44-47 (emphasis added)). Moreover, Shoolery et al. clearly states that its system enables travel agents – not the travelers themselves – "to make bookings in an

assisted, simplified, consistent manner," (col. 5, ll. 47-48 (emphasis added)). Quite simply, Shoolery et al.'s travel management system neither includes the claimed structure nor is capable of performing in the manner recited in the claims, as discussed above. As such, one having ordinary skill in the art would readily recognize that Shoolery et al.'s system of allowing traveler's to access a database and enabling a travel agent to complete reservations is vastly different from allowing the traveler's to complete reservations themselves. Consequently, Shoolery et al. clearly fails to render obvious each and every element or method step recited in the claimed invention.

With this in mind, the Examiner has taken Official Notice of a wide variety of features of the claimed invention in order to remedy the deficiencies of Shoolery et al. For example, the Examiner took Official Notice over the imagined idea "that in an enterprise, certain necessary events or projects of greater interest to the enterprise would take preference over an employee preference," (Final Office Action pages 11-12). In addition, the Examiner took Official Notice of the concept that "a traveler usually cancels a completed travel reservation," (Final Office Action page 11). However, Official Notice cannot be applied to such a wide variety of features because the Examiner's rationale is based solely on facts that are not "capable of instant and unquestionable demonstration as being 'well-known' in the art." M.P.E.P. § 2144.03 (7th ed. 1998). According to the MPEP, however, when a rejection is based on facts within the Examiner's personal knowledge, the data used to support that rejection should at least be stated as specifically as possible. See M.P.E.P. § 2144.03 (7th ed.

1998). As such, Applicants respectfully challenge the Examiner's uncorroborated embellishments of the teachings of Shoolery et al.

The Examiner's grounds for rejection also appear to rest on the faulty premise that the specific teachings of Shoolery et al. could be embellished to achieve the claimed invention. However, even if Shoolery et al. could be read to be capable of changed to result in the claimed invention, which it could not, the mere fact that a reference is capable of being modified in a manner imagined by the Examiner does not render the resultant modification obvious. Indeed, the MPEP clearly states that the "mere fact that references can be . . . modified is not sufficient to establish *prima facie* obviousness." M.P.E.P. § 2143.01 (7th ed. 1998 (emphasis added)). Additionally, there is no motivation in the record for one skilled in the art to modify Shoolery et al. in the manner suggested by the Examiner. It is only through *hindsight* afforded by Applicants' disclosure, in combination with the Examiner's assertion of Official Notice, that the Examiner can even assert that the teachings of Shoolery et al. suggest the claimed invention. Such hindsight determinations are impermissible under 35 U.S.C. § 103.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of all the pending claims 1-93.

Additionally, Examiner Poinvil is invited to telephone the undersigned Applicants' representatives at (202) 408-6052 if necessary to further expedite the prosecution of this application.

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D ck t No. 07099.0010-01

Please grant any necessary extensions of time and charge any additional fees due with the filing of this Amendment to our Deposit Account No. 06-0916.

Respectfully submitted,

**FINNEGAN, HENDERSON, FARABOW,
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By: 

Christopher W. Day
Reg. No. 43,944

Dated: June 27, 2000

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